

REMARKS

This Amendment and Response are made with a Request for Continued Examination, in reply to the Final Office Action dated March 28, 2005, in which the following rejections were made:

Claims 1 and 5-11 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Specifically, the Examiner alleged insufficient antecedent basis for a claim 1 term, and that claim 5 was not a proper dependent claim.

Claims 1 and 5-11 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,705,917 to Scott et al.

Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,654,970 to Nagashima in light of Scott.

Applicants respectfully traverse these rejections below. Claims 1 and 5-13 are currently pending, claim 5 has been cancelled and claims 1 and 6 have been amended, leaving claims 1 and 6-13 pending in this application.

Rejections under 35 U.S.C. § 112, ¶ 2, of Claims 1 and 5-11

Regarding the indefiniteness rejections, Applicant respectfully submits that, as amended, all claim 1 terms have the proper antecedent basis.

Regarding the claim 1 "connection for attachments," Applicant submits that amended claim 1 employs proper alternative claim language to distinctly point out the two alternative connection configurations recited within the claim. Should the Examiner reassert that the current alternative wording of claim 1 is not proper, Applicants respectfully request that the Examiner indicate the basis for this estimation. The Examiner's assistance in drafting claim language that is more acceptable to the Examiner is also hereby respectfully requested should the Examiner repeat the outstanding rejection of claim 1's alternative language.

As claim 5 has been cancelled, and the indefiniteness rejections of claims 6-11 were based on the indefiniteness of claim 1, Applicant respectfully submits that claims 1 and 6-11 satisfy the requirements of 35 U.S.C. § 112, ¶ 2.

Rejections under 35 U.S.C. § 102(b) of Claims 1 and 5-11 based on Scott

Regarding the anticipation rejections of claims 1 and 5-11 based on Scott, Applicant's claim 1 recites "A hand-held machine tool, having a direct mechanical utility..." Applicant respectfully submits that an electrical generator, such as disclosed by Scott, even if it may properly be considered a hand-held machine tool (which Applicant respectfully denies), does not have a direct mechanical utility. A chain saw, for example, has the direct mechanical utility of sawing. A generator conversely, while having a direct electrical utility, has mechanical utility only indirectly by means of powering something else.

As Scott does not disclose all of the recitations of independent claim 1, Applicant respectfully submits that for at least this reason, claim 1 and dependent claims 6-11, are allowable over Scott.

Applicant additionally notes, regarding the anticipation rejection of dependent claim 6, the claim 6 recitation of a connection for attachments "capable of inductive electrical energy transfer" is disclosed neither expressly nor inherently in Scott. While Applicant concedes that inductive energy transfer occurs within an electric generator, the claim 6 recitation is expressly directed to inductive *electrical* energy transfer *via the connection for attachments*, and not to the induction that occurs in the armature windings of a generator. The outlets 702 disclosed by Scott are standard electrical outlets that transfer electrical energy conductively via direct electrical contact between conductive elements on the plug and in the outlet. An example of inductive electrical energy transfer, on the other hand, would be a standard transformer arrangement, where there is not direct electrical contact, rather primary (supply side) windings generate a magnetic flux which induces a current in secondary (load side) windings. An advantage of this type of electrical energy transfer can be found in Applicant's Specification, p. 2: "This has the advantage that the working safety or operating safety of the machine is substantially increased since a short circuit or unintentional contact

between the voltage-carrying lead and the operator is avoided.” This advantage is not achieved by the standard outlets disclosed by Scott.

As Scott does not disclose all the recitations of claim 6, Applicant respectfully submits that for at least this reason, claim 6 is allowable over Scott.

Rejections under 35 U.S.C. § 103(a) of Claims 12 and 13 over Nagashima in light of Scott

Regarding the obviousness rejections of claims 12 and 13 over Nagashima in light of Scott, Applicant submits that the prima facie case of obviousness necessary to sustain such rejections has not been made. Specifically, MPEP 2143 states:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Applicant does not dispute that it would be obvious to put power connections on a sole-purpose electrical generator. However, Applicant is not claiming a generator, and cannot find any suggestion to add power connections to the chainsaw of Nagashimi. At best, Nagashimi is concerned with supplying a chainsaw with a heated handle for use in cold climates. This purpose does not require external power connections, and Nagashimi is absolutely silent regarding either the adaptability of the device for external power connections or even the desirability of such connections. Scott, being designed to *supply power to power tools* (col. 1, line 33), teaches away from modifying such tools to include outlets.

If the Examiner is taking Official Notice that such a combination would have been obvious to one of the ordinary skill in the art, Applicant respectfully repeats the request from his previous Response (filed January 31, 2005), “that the Examiner *provide a prior art reference*, in accordance with MPEP § 2144.03, in which it is shown to use a plug-socket on a [chainsaw] for powering an external consumer... in support of the Examiner’s Official Notice.”

As there is no motivation to combine the disclosures of Nagashimi and Scott, Applicant respectfully submits that for at least this reason, claims 12 and 13 are allowable over these references.

Applicant respectfully submits that the foregoing arguments regarding the current obviousness rejections apply with equal force against any combination of Nagashimi and Scott that might be applied with regard to claims 1 and 6-11.

No New Matter

Applicant respectfully submits that nothing in the current amendment constitutes new matter. Support in the Specification for the claim 1 recitation of a tool, "having a direct mechanical utility," can be found in Fig. 1 in which a chainsaw, which has a direct mechanical utility, is shown. See also Specification p. 1. For disclosure supporting both the original and amended claim 6, see Specification p. 2.

Summary of Telephone Interview

Applicant thanks the Examiner for the telephone interview granted to Applicant's attorney on June 6, 2005, and submits that the following accurately reflects the substance of that interview:

The Examiner indicated that upon receipt of the RCE and response, he would verify that the Preliminary Amendment filed with the application on July 9, 2003 was entered, and enter the current Specification amendments accordingly.

The Examiner reiterated his belief that including power connections on any apparatus with a generator was prima facie obvious, but indicated that if he sustained his rejection in light of the current response, he would very explicitly set forth his reasoning, and satisfy all requirements regarding Official Notice.

The Examiner indicated his willingness to particularly consider the patentability of Applicant's claim 6, in which a connection for attachments capable of inductive electrical energy transfer is recited.

The Examiner requested Applicant avoid any new matter issues by specifically referencing the application to support any claim amendments filed with the RCE.

Conclusion

As Applicant has traversed each and every rejection raised by the Examiner, it is hereby respectfully requested that Examiner withdraw the rejections of claims 1 and 6-13, and pass claims 1 and 6-13 to issue.

Applicant requests Deposit Account No. 13-0235 be charged \$790.00 for the Request for Continued Examination. Applicant believes that no additional fees are due in connection with this amendment and response. If any additional fees are deemed necessary, please charge them to the above-identified deposit account.

Do not hesitate to call Applicants' attorneys at the number below if they may help expedite the prosecution of this application in any way.

Respectfully submitted,

By 

Nicholas J. Tuccillo, Esq.
Registration No. 44,322
Attorney for Applicant(s)

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-4102
Tel: (860) 549-5290
Fax: (413) 733-4543